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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/450,385 11/29/99 KOWALEVICH

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EXAMINER

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WILKENS, K

ART UNIT

PAPER NUMBER

3635

DATE MAILED:

11/08/00

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/450,385**

Applicant(s)  
**Peter Kowalevich**

Examiner  
**Kevin Wilkens**

Group Art Unit  
**3635**



- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-9 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-9 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☒ The drawing(s) filed on Nov 29, 1999 is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☒ The specification is objected to by the Examiner.
- ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

### **OBJECTIONS TO THE DECLARATION**

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because it does not state whether the inventor is a sole or joint inventor of the invention claimed.

### **OBJECTIONS TO APPLICANT'S CITED ART**

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

### **OBJECTIONS TO THE ABSTRACT**

The abstract of the disclosure is objected to because of the implied phrase "is shown". Correction is required. See MPEP § 608.01(b), particularly the three sample abstracts contained therein.

### **OBJECTIONS TO THE DRAWINGS**

The drawings are objected to because of the following informalities: technically, there is no figure 4 per se; rather, there is a fig. 4A, 4B, 4C, and 4D. Each figure must have its own label. Thus, the legend

"Fig. 4" should be deleted. Figures 4A and 4C should not be linked in the manner shown by Applicant (i.e. with dashed lines to show where the clip is located on the panel). The arrows for sections lines B-B, D-D, 6A-6A, and 6b-6b are pointing in the wrong direction when referencing the actual sectional views in figs. 4B, 4D, 6A, and 6B respectively. In figs. 6A and 6B, the term "PANAL" should be "PANEL". In fig. 7, reference numbers "8A", "8B", "30a or b", and "30A or B" should be "8a", "8b", "30a or 30b", and "30a or 30b" for consistency with the specification and to avoid confusion in general. Correction is required.

Also, the drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 32. Correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the stop portion (i.e. claim 4), the indentations defining the individual shakes (i.e. claim 5), the simulated wood grain appearance (i.e. claim 7), the simulated wood texture (i.e. claim 8), and the simulated wood color and shading (i.e. claim 9) must all be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### **OBJECTIONS TO THE SPECIFICATION**

The disclosure is objected to because of the following informalities: as noted above, there technically is no "Fig. 4"; therefore, the brief description for this collection of figures should be revised similarly to what Applicant has done for figs. 5A through 6B. Similarly, the rest of the specification should be revised accordingly-- see page 13, line 13; page 14, line 12; page 15, lines 1, 15, and 19; and page 16, line 1. The brief description for fig. 4D should also be revised to indicate that the figure is a "partial" sectional view along line D-D. At page 10, last line, the phrase "6B-6B" should be "6b-6b" for consistency with the figures; a similar correction is required at page 16, line 8. At page 13, lines 9-14, reference numbers "8A" and "8B" should be "8a" and "8b" for consistency with the figures-- similar changes are required at page 14, line 9; page 15, line 17; and page 16, line 10 (for "8B" only). At page 13, line 20, reference numbers "24A"

and "24B" should be "24a" and "24b" for consistency with the figures. At page 13, line 20, reference number "22A" should be "22a" for consistency with the figures. At page 13, line 21, reference number "22C" should be "22c" for consistency with the figures. At page 14, lines 9-10, the phrase "22A, B and C" should be "22a, 22b, and 22c" for consistency with the figures and to eliminate confusion in general-- similar changes are required at page 16, line 14. Likewise, at page 16, line 14, the phrase "22A, 22B, and 22C" should be "22a, 22b, and 22c". At page 14, line 14, reference numbers "32A" and "32B" should be "32a" and "32b" for consistency with the figures-- similar changes are required at page 14, line 16; page 14, line 20 (for "32a" only); page 15, lines 15-17; page 16, line 3; and page 16, line 11 (for "32b" only). As noted above, figures should not be linked; therefore, the text at page 14, lines 17-18 should be revised accordingly. At page 14, line 21, reference number "30A" should be "30a" for consistency with the figures-- similar changes are required at page 15, line 4; and page 16, line 2 (as best understood when considering fig. 4B and the related text therefor). At page 15, lines 11-13, reference numbers "12A", "12B", "12C", and "12D" should be "12a", "12b", "12c", and "12d" for consistency with the figures-- similar changes are required at page 16, line 21 (for "12d" only); page 16, line 22 (for "12b" only); and page 17, line 1 (for "12c" only). Appropriate correction is required.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: it is unclear where support for the "stop portion" (i.e. claim 4), or the "indented, vertical region" (i.e. claim 5) limitations are found in the specification.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the Applicant regards as his invention.

Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claim 1 lacks antecedent basis for the phrase "said clipping members". Claim 3 lacks antecedent basis for the phrase "the sheets". Additionally, the scope of the claim is unclear; previously, Applicant has claimed a single sheet which is capable of being assembled to an adjacent sheet. However, the phrase "a first and a second of the sheets... slidably engaging one of said flanged assemblies" recites a positive connection between the two sheets. Therefore, it is unclear if the claim is directed to the combination of multiple sheets or the subcombination of a single sheet.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler in view of Hovind and Moliere. As the claims are best understood, Kessler discloses the claimed invention in figs. 1 & 2. An interlocking rectangular sheet (e.g. 2a) has an exposure surface facing away from a substrate (4) to which the sheet is secured. A U-shaped clipping member (10, 12, and the portion of sheet 2a spaced from 12 by portion 10) is configured along the bottom of the sheet below the exposure surface as shown in the figure(s). A plurality of key portions (8) are placed along the top of the sheet above the exposure surface. A plurality of independent, apertured, flanged assemblies (e.g. 16) are flexibly attached (i.e. they are capable of sliding along the sheet, but are secured thereto, via fastener (18) and the elongated keys (8)) about the keys. The configuration of the flanged assemblies is such that they cooperate with the U-shaped clipping members of adjacent panels when assembled as shown in fig. 1. Kessler's flanged assemblies have a first portion

parallel to and abutting the top surface of the sheet (this portion also including the hole to receive fastener 18), a second portion angled (i.e. 90°) outwardly from the first portion, and a third portion (14) substantially parallel to the first portion. An aperture is thus formed between the flanged assembly and the surface of the sheet for the reception of the U-shaped clip as discussed above. It is noted that Kessler indicates (i.e. claim 1) that the number of flanged assemblies corresponds to the number of keys. However, there is no specific mention of the following: that the sheet is formed to simulate a plurality of shakes delineated by vertical indentations; that there are fewer flanged assemblies than keys (such that not all of the keys have a flanged assembly associated therewith); or that the sheet has a simulated wood grain, wood texture, and/or wood color/shading appearance.

Hovind discloses, as shown best in figure 2, a similar arrangement where there are fewer attachment clips or "flanged assemblies" (10) than the number of keys (38). Moliere discloses a sheet having an exposure surface configured with simulated wood shakes (e.g. 12); clearly, these shakes have a simulated wood grain or wood texture appearance. As shown in figures, vertical indentations (13) are used to demarcate the individual shakes from the panel proper. Note further the "flanged assemblies" (40) which cooperate with the surface of the sheet to receive U-shaped clips (50) of an adjacent panel-- see also figs. 4-6. Using fewer flanged assemblies than the total number of keys in Kessler's system would have been obvious to one of ordinary skill in the art, based upon the teachings of Hovind. Clearly, Hovind indicates that it is unnecessary to use a flanged assembly for every key, and thus the assembly time and expense required for Kessler's system is reduced; one might argue that Kessler's use of a flanged assembly for every key is overkill, based upon the teachings of Hovind. Furthermore, Kessler's system remains functionally equivalent, since the sheet(s) is still securable to the wall substrate (4), and adjacent panels are securable between the flanged assembly and the underlying sheet as intended. Forming the Kessler/Hovind sheet to appear as shakes would have been an obvious design consideration for one of ordinary skill in the art, based upon the teachings of Moliere and the desired aesthetics for the assembled wall. Clearly, panels formed with simulated

shakes were known in the art at the time of the instant invention. Therefore the combined Kessler/Hovind/Moliere sheet remains functionally equivalent regardless of the aesthetic appearance (note, too, that Moliere indicates that the sheet can be formed to simulated tile, slate, brick, etc. as desired). The interconnection of the sheet to the wall and/or to additional sheets is not affected by the aesthetics of the exposure surface. Forming the Kessler/Hovind/Moliere sheet with a wood color and/or shading would have also been an obvious design consideration for one of ordinary skill in the art, based upon the desired aesthetics for the panel. For example, if the panel is intended to appear as wood shakes, the finished product should not be metallic in coloration. Whether this coloration/shading is a result of the material used to form the panel or a later step in the manufacturing process (i.e. painting) is immaterial.

Note that limitations such as "thermo-formed", "punched key portions", "extruded assemblies", and "weldedly, flexibly attached" are given little (if any) patentable weight with respect to article claims, as such limitations are of a "product-by-process" nature. The patentability of a claim to a product does not depend on merely a difference in its method of production, but on whether the product itself is new and unobvious. *In re Pilkington*, 411 F.2d 1345, 1348, 192 U.S.P.Q. 145, 147 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803, 218 U.S.P.Q. 289, 292-93 (Fed. Cir. 1983); *Johnson & Johnson v. W. L. Gore & Associates, Inc.*, 436 F. Supp. 704, 726, 195 U.S.P.Q. 487, 506 (DC Del. 1977); see also *In re Fessman*, 489 F.2d 742, 180 U.S.P.Q. 324 (CCPA 1974) and *In re Thorpe*, 777 F.2d 695, 227 U.S.P.Q. 964 (Fed. Cir. 1985). When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 450 F.2d 531, 173 U.S.P.Q. 685 (CCPA 1972). This burden is NOT discharged solely because the product was derived from a process not known in the prior art. *In re Fessman, supra*.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler in view of Hovind and Moliere as applied to claims 1, 5, and 7-9 above, and further in view of Katz. As discussed above, the claimed invention is disclosed by the combined teachings of Kessler/Hovind/Moliere. However, there is no specific mention that the flanged assembly includes a fourth portion angled outwardly from the third portion thereof. Katz discloses, as shown best in figs. 6-8, an element (e.g. 140) of a "flanged assembly" which is angled outwardly from the rest of the member. The U-shaped clip of an adjacent panel is received in the aperture formed between the sheet and the flanged assembly, much like that of the Kessler/Hovind/Moliere unit. Katz's element (140) serves as a "guide lip" to assist in the assembly of adjacent panels. Such guide lips on flanges were well-known in the art at the time of the invention. Providing a guide lip (as taught by Katz) to the flanged assembly of Kessler/Hovind/Moliere would have been obvious to one of ordinary skill in the art to aid the installer during "blind" assembly of adjacent sheets as was known at the time of the instant invention. Such a guide lip would become the "fourth" portion of the Kessler/Hovind/Moliere/Katz device, and would not adversely affect the overall combination.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kessler in view of Hovind and Moliere as applied to claims 1, 5, and 7-9 above, and further in view of Hoofe, III. As discussed above, the claimed invention is disclosed by Kessler/Hovind/Moliere. However, there is no specific mention that the vertical indentations that delineate the shakes are of varying width to further enhance the appearance of the simulated shakes. Hoofe discloses, for example in figs. 1 & 2, a similarly configured simulated wood shake panel. Vertical indentations (36) are provided to delineate the individual shakes; as mentioned in col. 4, lines 16-64, as well as being shown in the figures, these indentations may be varied (including with respect to their width) to provide a more realistic wood shake appearance to the panel. It would have been an obvious design consideration for one of ordinary skill in the art to vary the widths of the Kessler/Hovind/Moliere shake indentations (based upon the teachings of Hoofe), to therefore provide the most realistic-looking

simulated shake panel possible. The varied indentation width reduces the appearance of patterns on the assembled wall, and does not adversely affect the Kessler/Hovind/Moliere/Hoofe system.

### **CITATION OF POTENTIALLY ALLOWABLE CLAIMS**

Claims 3 and 4 would appear to be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims. The allowable subject matter is directed to the location of the notches in the top and bottom edges as claimed (i.e. claim 3). While the prior art discloses "offset" edges (note Crick for example), none of the prior art appears to disclose notches in the manner claimed by Applicant. It is thus the Examiner's opinion that such a modification in the (for example) Kessler panel would only be possible through impermissible hindsight reasoning.

### **CITATION OF PERTINENT ART**

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

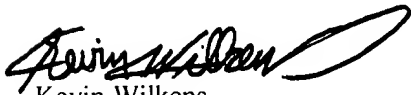
### **INQUIRY CONTACTS**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kevin Wilkens whose telephone number is (703) 308-0710. The Examiner can normally be reached on Mondays through Thursdays from 7:30a.m. to 5:00p.m. The Examiner can also be reached on alternate Fridays between 7:30a.m. to 5:00p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Carl D. Friedman, can be reached at (703) 308-0839, Mondays through Thursdays between the hours of 6:30a.m. to 4:00p.m., and on alternate Fridays between 6:30a.m. to 3:00 p.m. The fax numbers for Official

submissions to the organization where this application or proceeding is assigned are (703) 308-3597, (703) 308-7687, or (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Kevin Wilkens  
November 4, 2000



Carl D. Friedman  
Supervisory Patent Examiner  
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